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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,134	03/22/2001	Yuki Uchida	2271/61807	4845

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/815,134	<b>Applicant(s)</b> UCHIDA, YUKI	
	<b>Examiner</b> Andrew J. Fischer	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/22/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*Handwritten mark*

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on April 29, 2005. This application was under a final rejection (the First Final Office Action, mailed January 6, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the previous First Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

### ***Acknowledgements***

2. In accordance with the RCE noted above, Applicant's after final amendment filed April 18, 2004 has been entered. Accordingly, claims 1-23 remain pending.
3. Claims 11-23 were withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made with traverse in the reply filed on April 21, 2004.
4. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

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5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

### ***Drawings***

6. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP §608.02(g). Corrected drawings in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 C.F.R. §1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

7. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 5, and 10 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 3, it is unclear who is "automatically recognizing . . . ."
- b. In claims 5 and 10, the phrase "wherein said step of automatically identifying occurs on the user-side" is indefinite because it is unclear what occurs on the user-side.

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***Claim Rejections - 35 USC §102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-4 and 6-9, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Sloane et. al. (U.S. 6,434,530 B1)(“Sloane”). Sloane discloses automatically identifying, without reliance on user action, a selected aspect of information regarding the electronic transaction (e.g. price of each item and total cost) in an electronic communication between the user-side (the customer) and the supplier-side (the seller); generating a print request (performed automatically by the software); sending said print request to a printing apparatus (to printer 708); printing information regarding the electronic transaction in response to the print request (the customer’s receipt is printed); notifying a control apparatus of communication between the user-side and supplier-side.

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***Claim Rejections - 35 USC §103***

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4 and 6-9, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable what is well known in the art. Applicant's original specification describes solutions and notes that "[i]n another method, the record information is printed as a result of an instruction on the supplier side of the communication with the paper copy of the record being mailed to the user subsequently."<sup>1</sup> While Applicant's specification does not directly "automatically identifying without user action," the specification offers indirect or circumstantial evidence that this is inherent since the user has no input, no decision, or no way of controlling the printing of the receipt.

13. Claims 5 and 10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable what is well known in the art and in further view of Dutta (U.S. 6,681,246 B1). What is known in the art discloses as discussed above. However, it is not directly disclosed to have the printing occurring on the user's side. Dutta teaches having receipt information automatically printed at a user's computer. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the prior art to include Dutta's ability to push receipt information to a user's printer. Such a modification would have given the user immediate notice of their purchase.

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14. Claims 5 and 10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Dutta. Sloane discloses as discussed above.

However, it is not directly disclosed to have the printing occurring on the user's side. Dutta teaches having receipt information automatically printed at a user's computer. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the prior art to include Dutta's ability to push receipt information to a user's printer. Such a modification would have given the user immediate notice of their purchase.

15. Claims 1-10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Wong (U.S. 6,115,690) in view of Dutta. Wong discloses automatically identifying, without reliance on user action, a selected aspect of information regarding the electronic transaction (*e.g.* items shipped to the customer) in an electronic communication between the user-side (the customer) and the supplier-side (the seller) (the transaction was over the Internet); generating a print request (performed automatically by the software); sending said print request to a printing apparatus printing information regarding the electronic transaction in response to the print request (the packing slip is automatically printed and included in the order); notifying a control apparatus (a communications server, a bridge, or router within the Internet) of communication between the user-side and supplier-side.

16. Wong does not directly disclose sending said print request to a printing apparatus. However, because Wong directly discloses that the packing slip is automatically printed, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Wong to expressly recite that the software sends a print request to the printer (as

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<sup>1</sup> Applicant's original specification, in the "Background" section, pages 2-3.

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is the case with virtually all printers). Such a modification would have simply expressly disclosed how a standard print request is handled in an ordinary printer.

17. The Examiner interprets the phrase “without reliance on user action” as only limiting the phrase “automatically identifying . . . a selected aspect of user information regarding said electronic transaction.” In other words, the phrase “without reliance on user action” has no effect on the other aspects of the claim. For example, it is axiomatic that the “transaction conducted electronically” requires, at least in part, some user action. See e.g. White & Summers noting that consent by both buyer and seller is needed for a transaction. Thus, the “transaction conducted electronically” could never occur because an electronic transaction (like all transactions) must rely on at least *some* user action.

18. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>2</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and

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<sup>2</sup> See the First Final Office Action mailed January 6, 2005, Paragraph No. 18; and the First Non Final Office Action mailed July 14, 2004, Paragraph No. 16.

<sup>3</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, *at the very least*, point to a term or terms in the claim



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precision.<sup>4</sup> Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>5</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R.

§1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own lexicographer.<sup>7</sup> It remains the Examiner's position that these requirements were reasonable.<sup>8</sup> Accordingly and for due process purposes, the Examiner gives

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with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See note 2.

<sup>6</sup> *Id.*

<sup>7</sup> See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.").

<sup>8</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed July 10, 2005).

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notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>9</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>10</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

19. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner’s claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>11</sup>) during ex parte examination.

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<sup>9</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>10</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

<sup>11</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

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20. The Examiner maintains his position that all examined claims do not contain product-by-process limitations.

### *Response to Arguments*

21. Applicant's arguments filed March 29, 2005 have been fully considered but they are not persuasive.

22. Applicant argues that "Beatson, although electronic, is not, however, a system for conducting a transaction electronically between a user-de and a supplier-side."<sup>12</sup> The Examiner respectfully disagrees. Claim 1 expressly states "a transaction conducted electronically . . . ."

Because claim 1 has the transitional phrase "comprising," it is considered to have an open transitional phrase. See MPEP §2111.03. Therefore to anticipate or render obvious, it is the Examiner's position that the transaction must be conducted electronically at least in part. And the use of a credit card verification system or any other electronic means such as a signature capture device would then be "a transaction conducted electronically" at least in part.

Applicant's arguments have been considered but are not persuasive.

23. Regarding Wong, Wong is used to show a typical transaction performed over the Internet.

### *Conclusion*

24. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

Unless expressly noted otherwise by the Examiner using appropriate designations on form PTO-

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<sup>12</sup> Applicant's Remarks filed March 29, 2005, page 13, ¶3.

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892 (*e.g.* page numbers, chapter selections, or other indicia), all references listed on form PTO-892 are cited in their entirety.

25. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

27. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 11) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal

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conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>13</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
July 10, 2005

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<sup>13</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.